



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,706	06/25/2003	Eiki Yasukawa	03248C/HG	5090

1933 7590 02/27/2007

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC  
220 Fifth Avenue  
16TH Floor  
NEW YORK, NY 10001-7708

EXAMINER

MERCADO, JULIAN A

ART UNIT

PAPER NUMBER

1745

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/606,706

Applicant(s)

YASUKAWA ET AL.

Examiner

Julian Mercado

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) 1,2,5-7,16 and 17 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 3, 4, 8-15, 18-30 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Remarks***

This Office action is responsive to applicant's amendment filed on October 16, 2006.

Claims 1-30 are pending, of which claims 1, 2, 5-7, 16 and 17 are withdrawn from consideration.

### ***Claim Objections***

Claims 8, 12 and 30 are objected to because of the following informalities:

1. In claim 8 at line 3, it is suggested to change "selected from" to --selected from the group consisting of--, in order to more properly recite a Markush-type limitation (such, for example, recited in claim 10 line 3)
2. Claim 30 at line 6 and line 7 (both instances) recites a similar limitation to claim 8 and is objected to under the same grounds.
3. In claim 12 at lines 3-4, it is suggested to change "ethyelne carbonate" to --ethylene carbonate--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1745

Claims 8, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, 11 and 12 presently depend from a non-elected claim (claim 7). Thus, the scope of claims 8, 11 and 12 are indefinite, though it is noted that in reciting compounds (b1) and (b2) in the alternative the claims are co-extensive in scope with elected Group (b) with respect to the former compound. If applicant intends to amend the dependency of claims 8, 11 and 12 so as to depend from claim 3, it is further suggested to amend claim 3 by changing "(b1) a cyclic carbonate" to -- (b) at least one compound selected from the group consisting of (b1) a cyclic carboxylate and (b2) a cyclic carbonate--.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 4, 8-15, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Tan et al. (JP 11-260401).

The rejection is maintained for the reasons of record. The examiner notes that the claims are presently pending as originally filed. The examiner also notes that applicant's sole remark in reply to the prior Office action is in reference to the declaration submitted by Shigematsu dated October 5, 2006.

Art Unit: 1745

The declaration under 37 CFR 1.132 filed on October 16, 2006 is insufficient to overcome the rejection of claims 3, 4, 8-15, 18 and 19 based upon Tan et al. as set forth in the last Office action because the facts presented are not germane to the rejection at issue. While the examiner is aware that filing an affidavit or declaration under 37 CFR 1.132 may be submitted to show that the reference invention is not by "another," this provision is only for 35 U.S.C. 102(a) or 102(e) rejections, and the Tan et al. reference is presently applied under 35 U.S.C. 102(b). Section (I) of the declaration states its intention to "prove that the present invention is not obvious over the references cited by the examiner...." In reply, it is asserted that the Tan et al. reference is an anticipatory teaching, and the declaration is silent in persuasively arguing that the claims are patentably distinguishable from the prior art. Furthermore, no amendments to the claims are present, thus there appears to be no attempt to amend the claims to patentably distinguish over the prior art.

Additionally, the declaration is also not found commensurate in scope with the claims, insofar as both vinylene carbonate compound (c1), vinylethylene carbonate compound (c2), cyclic amide compound (d1), cyclic carbamate compound (d2) and a heterocyclic compound (d3) is relied upon, while the claims state these compounds in the alternative, i.e. "at least one" language. See pages 2 and 4 in comparison to independent claim 3. Furthermore, the examiner notes that compounds (d1), (d2) and (d3) are drawn to a non-elected species.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1745

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tan et al. in view of Sonobe et al. (U.S. Pat. 5,527,643) and Kameda et al. (U.S. Pat. 6,632,569 B1).

Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tan et al. in view of Sonobe et al. and Kameda et al., and further in view of Watanabe et al. (U.S. Pat. 6,682,856 B1).

The rejection(s) is maintained for the reasons of record. The declaration under 37 CFR 1.132 filed on October 16, 2006 is insufficient to overcome the rejection of claims 20-27 based upon Tan et al. in view of Sonobe et al. and Kameda et al. as set forth in the last Office action because evidence of unexpected results must compare the claimed invention with the closest prior art. The comparisons made in the declaration are against examples "which do not contain either of the vinylene carbonate compound (c1) or the vinylethylene carbonate compound (c2)." (pages 2, 4 and 6) The comparative examples are not deemed representative of the prior art insofar as Tan et al. teaches a compound (c1) of a vinylene carbonate derivative. See the prior Office action on page 4.

Additionally, the extent to which the present invention may have unexpected results with respect to flame retardancy, nonflammability and high conductivity cannot be ascertained in relation to the prior art because the comparisons made in the declaration fail to fairly represent the teachings of the latter, especially in view of Tan et al. being readable on the claims as set forth under 35 U.S.C. 102(b)

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number: 10/606,706

Page 7

Art Unit: 1745

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



jam



PATRICK J. SCOTT  
SUPERVISORY PATENT EXAMINER